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From: DGrantK@aol.com

Sent: Monday, May 08, 2006 4:28 PM

To: DDP.Comments

Cc: IAGBOB@aol.com; UIAUSA@aol.com; Kirik, Cathie

Subject: Comments from the United Inventors Assn. re: Discl. Doc. Program

Please see attached.

Thank you.

Thanks

Don Kelly
for the UIA



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May 8, 2006

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
And Director of the US Patent & Trademark Office
Sent by Electronic Mail Message to:
Ddp.comments@uspto.gov

Attn: Ms. Catherine M. Kirik
Office of the Commissioner for Patents

Comments on Proposed Rule:
*Changes to Eliminate the Disclosure
Document Program*

Dear Under Secretary Dudas:

The following comments are presented on behalf of the United Inventors Association (UIA) relative to a *Federal Register (FR)* notice recently posted by the United States Patent and Trademark Office (USPTO). The subject *FR* notice concerns the disposition of the Disclosure Document Program (DDP) established in 1969.

The UIA is grateful to have this opportunity to offer comments. Further, the UIA has taken the liberty of offering a proposal for future handling of Disclosure Documents.

About the United Inventors Association

The UIA, based in New York, was founded in 1990 as a *not-for-profit* corporation and has grown to become the world's leading inventor organization. Existing solely for the purpose of educating inventors and entrepreneurs, the UIA represents more than 10,000 inventors worldwide. We offer membership support, newsletters (paper and electronic), workshops, web-based resources, publications, and collaboration with a range of partners with mutual interests. UIA membership is extended to inventor organizations as well as to individual inventor/entrepreneurs and professional service providers who meet specific performance criteria.

The UIA has enjoyed a number of cooperative initiatives with the USPTO, for example, organizing and/or co-hosting USPTO national inventor conferences. More recently, the UIA has actively participated in briefing sessions and discussions hosted by the USPTO's Office of Legislation and International Affairs relative to ongoing treaty deliberations abroad.

The Document Disclosure Program

The subject *Federal Register* / Vol. 71, No. 66, dated April 6, 2006 announced that the USPTO (the Office) “has determined that it is now appropriate to propose elimination of the Disclosure Document Program.” The determination, according to the Office, is based on an observation that “independent inventors have become more familiar with and are using provisional applications more often than they were in 1998. Included in the Notice is a proposed change to 37 CFR 1.21.

The USPTO’s reference to 1998 recalls an earlier notice seeking customer opinion relative to the value of the DDP and whether it should be continued. The USPTO reports having received no responses from the independent inventor community to the 1998 inquiry.

Informal Survey of the Inventor Community

In preparing the present response, the UIA undertook an informal survey of its membership and also reached out to others throughout the inventor community, including those frequenting popular Internet-based list-serve exchanges. UIA raised the issue of proposed elimination of the DDP. Response to the UIA’s informal survey has been mixed.

All respondents confirmed an awareness of the DDP as it currently exists; many had used the DDP in the past and/or had recommended it to others particularly in lieu of the long-denounced *self-addressed envelope* form of evidence. Hostility among some of the respondents was palpable as they point to what they view as efforts to dismantle America’s *first-to-invent* system.

No one shares the perception advanced by the USPTO (in both the recent FR notice and that of 1998) that the provisional patent application is a viable alternative to the disclosure document.

Those surveyed wrote or voiced their understanding of the disclosure document as a means for establishing evidence an early date of invention conception, believing this to be a linchpin of inventors’ rights under the existing *first to invent* environment. They assert that the disclosure document bolsters “*inventor journal*” entries that too often are poorly maintained outside the corporate setting. Some admitted to filing a series of disclosure documents aligned with progress or changes in their invention developments, noting that the \$10.00 fee associated with each filing seemed a good exchange for a sense of security.

As suggested by the USPTO, some respondents concurred that disclosure documents (and what they do for the inventor) are misunderstood by many. Some respondents related concern for the manner in which scurrilous invention marketing firms (IMF’s) have taken advantage of the DDP by filing disclosure documents on behalf of uninformed inventors, then billing exorbitant fees for the service. But, some also noted awareness of an emerging trend by IMF’s filing provisional patent applications (PPA’s) for inventors and using the same abusive tactic.

Speaking of the PPA, the UIA's informal survey found that, with very few exceptions, the PPA is viewed as something quite apart from the DDP. They see the PPA as demanding considerably more commitment to entry into a patenting process with its attendant expense, timelines, complications and expense. They also noted that the PPA, today, is no longer the *do-it-yourself* document most thought it to be when introduced a decade ago. When faced with the UIA's direct question, "*Should the USPTO discontinue the Disclosure Document Program?*" one seasoned inventor countered: "*Ain't people using it?*" -- a question that would be repeated by others, though none so colorfully.

The UIA, to date, is unable to report with any amount of certainty just how much the inventor community values the DDP. It is believed that the DDP is most valued by the very early inventor community entrants, and these people are especially difficult to reach. By the same token, the UIA also is unable to explain to its membership why the program stands as a candidate for elimination.

The DDP's *value* to the public is most likely reflected in its level of use. With its *Federal Register* notice of October 5, 1998 the USPTO reported as many as 35,000 disclosure document filings per year, a level that most likely would by now have increased along with the 50% increase in other USPTO filings. So, this answers the seasoned inventor's candid question as posed above.

Is the DDP abused? Certainly, the DDP is abused as evidenced by the USPTO's source identification of documents filed. But on the other hand, PPA's and even NPA's also are filed by unscrupulous marketing firms. Is the conversion rate from disclosure document to patent application very low? Reportedly, yes. But encouraging those early stage inventors to move directly to PPA filing would do no good for either the inventor or the USPTO. And the UIA, as an institution prideful of its important role in educating inventors will not in good conscience send its membership back to the *self-addressed envelop* as a way of establishing evidence of conception. Neither should the USPTO.

All the UIA can report is a general impression that the problem alleged in the subject Notice has not been adequately framed and the needs of those citizens most likely to be impacted, namely the very early-stage customers of the DDP, have not been fully explored.

UIA Counterproposal

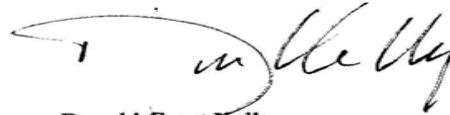
From all UIA can gather, the USPTO is quite serious in this most recent proposal to eliminate the DDP despite uncertainties about the value of the program or the impact of its elimination. Further, the UIA is well aware that at least some support for DDP elimination has been offered from other quarters. Undoubtedly, the USPTO Director will decide and take whatever action is determined best for the Agency. In this respect, the UIA wishes to offer an alternative.

The UIA is fully prepared to take on the management of the DDP. A UIA "DDP-like" program already enjoys the unanimous approval of the UIA Board of Directors. It would be handled by the UIA staff much in the same way other UIA-based inventor-service programs currently are managed. UIA would welcome immediate discussions with the USPTO relative to Agency outsourcing of the DDP. In preparing for this proposal, UIA has successfully completed initial negotiations with a qualified company that will establish a special UIA *innovation safeguard security* registry.

The UIA's "DDP" initiative would provide the benefits of the current DDP, except of course for the "USPTO witnessing" aspect. An added feature of the UIA initiative would be an invention *publishing* feature for inventors who want it for a variety of reasons. Perhaps the most positive aspect of such an arrangement would be the UIA's long standing reputation within the inventor community and for waging a relentless campaign against invention marketing firms.

Please contact the UIA for a further discussion of these issues and to explore the possibilities of a USPTO ~ UIA alliance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Donald Grant Kelly", with a large, stylized flourish at the end.

Donald Grant Kelly
President

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